

REMARKS

Claims 1-5 and 18-32 remain pending. Claims 1, 3, 18-21, 24 and 30-32 are amended. For at least the following reasons, the claims are believed to be in condition for allowance.

Claim Rejections – 35 U.S.C. § 112

Claims 1-5 and 18-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. These claims have been amended to overcome the deficiencies identified by the Examiner.

Claims 4, 18-23 and 25-32 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that the “single ... material” limitation of claim 4 is new matter. Contrary to the Examiner’s conclusion, support for this limitation is found throughout the specification. Among other places, support for this limitation is found on page 4, lines 14-21. This teaches, for instance, that “[t]he body 12 can be formed of any thin, plastic film, fibered-paper, or other similar material.” It further teaches specifically that the material can be biaxially-oriented three-ply polypropylene film, or a Mylar[®] film, for instance. The specification therefore clearly teaches the use of a single material for the sheet of film forming the body of the wall patch. The use of the word “single” in claims 26-29 is supported by the specification for at least these same reasons.

With respect to the “non-perforated” and “contiguous” limitations of claims 18 and 30, Applicant again respectfully disagrees with the Examiner’s assertion that this is new matter. The drawings clearly show the lack of perforations or other holes in the sheet of material forming the wall patch. FIG. 1A, for example, clearly shows that the sheet of material 12 of the preferred embodiment lacks perforations or other holes. This limitation has nonetheless been removed from the claims as it is unnecessary to distinguish over the prior art of record.

Claim 21 has been amended to explain that the center reinforcement is placed on the wall beneath the remaining wall patch structure. Each of the rejections under 35 U.S.C. § 112 are therefore overcome.

Claim Rejections – 35 U.S.C. § 103

Claims 1-5 and 18-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens, et al., taken either individually, or alternatively as evidence of the state of the art in view of Swallow for claims 1-5, 20, 31 and 32, for claim 5 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada.

Claims 1-5 and 24-29 further stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman, Sr. '949, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for all of the rejected claims, and for claim 5 in view of the FASSON publication.

In making each of these rejections, the Examiner improperly relies on a hindsight reconstruction of the claims—using the teachings of Applicant's invention to piece together the prior art references. The Examiner also improperly attributes knowledge to those of ordinary skill in the art without any supporting evidence.

“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (citing *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984)). A *prima facie* case of obviousness requires a showing that each and every element of the claims is present in some combination of prior art references, or that the claimed invention would be an obvious modification of those references. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). To establish a *prima facie* case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination made by the Applicant. *See In re Raynes*, 7 F.3d 1037, 1039 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Therefore, the PTO “can satisfy [its] burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d at 1074 (citing *In re Lalu*, 747 F.2d 703, 705 (Fed. Cir. 1984); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n. 24 (Fed. Cir. 1985); and *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))

(emphasis added). Obviousness cannot be established by hindsight combination to produce the claimed invention. *See, e.g., In re Gorman*, 933 F.2d 982, 986 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

The Examiner, however, fails to identify any teaching, suggestion, or motivation to combine the prior art in the manner claimed, instead substituting his own judgment gleaned from the teachings of Applicant's invention. The Examiner also improperly relies on his own subjective judgment to supply limitations wholly missing from any of the prior art of record, including the wall patch having "a substantially uniform thickness" and the presence of a "pre-textured" ready to paint layer. The Examiner has also failed to identify any piece of prior art that teaches "non-uniform serrations." For these reasons alone, the Examiner has failed to establish a *prima facie* case of obviousness and the claims are allowable.

In addition, however, Applicant submits herewith the Declaration of Jerry E. Brower and accompanying Exhibits, as well as the Declaration of Gale Bruns. As evidenced by these declarations and exhibits, the present invention would not have been obvious to those of ordinary skill in the art at the time of the invention. These Declarations and Exhibits further demonstrate that the Examiner's rejections are based on the inappropriate application of hindsight and lack any sufficient motivation, teaching, or suggestion to combine the references in the manner claimed.

As evidenced by the accompanying declarations and exhibits, Applicant's invention presented a new and non-obvious advancement in the art by providing a novel combination of features not previously available. This invention thereby satisfied a long-felt but unsolved need in the industry. Applicant's invention has further enjoyed tremendous commercial success since the introduction of its first commercial embodiment in 1999. In addition, despite the fact that no similar solutions were available prior to Applicant's invention, numerous other companies have directly copied and/or attempted to license Applicant's technology following its public introduction. Significantly, the industry has also recognized the importance of this invention through industry awards and in other ways. For each of these and other reasons, the Examiner's obviousness rejections are improper and should be withdrawn.

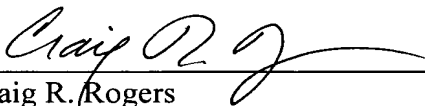
In addition to the foregoing, Applicant has further amended claims 30-32 to use the introductory phrase "consisting essentially of." The use of this phrase is further believed to distinguish these claims over the prior art of record and place them in condition for allowance.

CONCLUSION

Applicant's invention represents a new, novel, and non-obvious combination of features that satisfied a long-felt but unsolved industry need. For at least the foregoing reasons, reconsideration and allowance of claims 1-5 and 18-32 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, PC



Craig R. Rogers
Reg. No. 43,888

MARGER JOHNSON & McCOLLOM, PC
210 SW Morrison Street, Suite 400
Portland, Oregon 97204
Telephone: 503-222-3613
Customer No. 20575